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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,003	03/31/2004	James Caron	CPEQ 2 00008	6060
27885	7590	11/01/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			FERGUSON, MARISSA L	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,003

Applicant(s)

CARON, JAMES

Examiner

Marissa L. Ferguson

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11, 13, 14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14 and 16-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11,13,14,16-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over Bradley et al. (US Patent 4,867,057) in view of Smith et al. (US Publication 2001/0000860).

Regarding claim 11, Bradley teaches a method and system comprising a press (28) having press members for creating forces for pressing the media (44) against the embossing template (20') and an elastomeric embossing pad (24) disposed between the media (44) and the press (Figures 10 and 11) which deforms during pressing to spread the press forces over the embossing template and reduces pressure during pressing. However, he does not explicitly disclose selecting an elastomeric embossing pad having a selected hardness and placing the selected pad against the media. Smith et al. teaches selecting a pad with different hardness (Paragraphs 0023 and Table on page 2).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Bradley et al. to

include a step of selecting a pad as taught by Smith et al., since Smith et al. teaches it is advantageous to provide reliable embossing performance.

Regarding claims 13 and 14, Bradley et al. teaches a method and system comprising an embossing pad with a Shore hardness from about A20 to A80 (Table on page 2).

Regarding claims 16-20, Bradley et al. teaches the claimed invention with the exception of a method of selecting hardness and system with an elastomeric embossing pad formed of rubber, synthetic, silicone, polymer and urethane. Smith et al. teaches an embossing device with a method of selecting hardness and an embossing pad formed of rubber, synthetic, silicone, polymer and urethane (Page 2, Paragraph 0023). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Bradley et al. to replace the embossing pad thereof, with an embossing pad formed of rubber, synthetic, silicone, polymer and urethane as taught by Smith et al., since Smith et al. teaches it is advantageous to exhibit favorable properties in order to maximize resiliency of the pad.

Regarding claims 21 and 22, Bradley teaches a method wherein the embossing template is an embellishing and/or embossing die (20,20').

Regarding claims 24 and 25, Bradley teaches a method and system comprising a rigid platen plate (Column 8, Lines 3-10) with first and second portions (Figures 9 and 10) for pressing with the media (40), the embossing template (20,20') and the elastomeric pad (24) therebetween (Figures 9 and 10).

Regarding claim 26, Bradley et al. teaches all that is claimed except for a platen plate assembly formed of high-density polyethylene. Smith et al. teaches an embossing pad that can be made of such materials as rubber, synthetic, silicone, etc. However, Bradley et al. and Smith et al. do not teach the claimed vinyl embossing pad. It has been held to be within the general skill of a worker in the art to select a known material on the basis of suitability for intended use of making an embossing pad and a platen plate assembly. It would have been obvious to select a vinyl since such a modification would result in an embossing pad with a higher or a lower hardness to increase/decrease the spread of forces. Further, it would have been obvious to select a high-density polyethylene since such a modification would result in a cutting surface that is not easily dulled.

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over Bradley et al. (US Patent 4,867,057) in view of Smith et al. (US Publication 2001/0000860) as applied to claim 11, and further in view of Schutz (US Patent 4,361,085).

Bradley et al. teaches the claimed method and invention with the exception of an embossing template that is not a die and wherein the press is a roller press. Schutz teaches an embossing apparatus with an embossing template roller (11) and a press roller (13). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Bradley et al. to replace the embossing die and a press thereof, with an embossing roller and roller

press as taught by Schutz, since Schutz teaches that it is advantageous to provide high quality embossing definition on a web.

### ***Response to Arguments***

5. Applicant's arguments filed 8/8/05 have been fully considered but they are not persuasive. In response to applicant's arguments on pages 5 and 6, the Smith reference teaches selecting a pad that has desirable qualities, such as hardness. Since, the hardness is selected, this reference teaches the selecting limitation of applicant's claims. Although, Smith does not specifically state that the selecting step is for the purpose of adjusting the amount of spread, one having ordinary skill in the art would recognize that any pad hardness will adjust the spread as composed to a different hardness. Smith, therefore, teaches the positively claimed selecting step of applicant's invention.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other(F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson  
Examiner  
Art Unit 2854

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**ANDREW H. HIRSHFELD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**